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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/992,252 | 11/16/2001 | Mohamed Khalil | P1020 (13918RRUS01U) | 5357 |
| 64458 7590 03/19/2007 HEMINGWAY & HANSEN, LLP 1717 MAIN STREET BANK ONE CENTER, SUITE 2500 DALLAS, TX 75201 | | | EXAMINER SOL, ANTHONY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2616 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/992,252

Applicant(s)

KHALIL ET AL.

Examiner

Anthony Sol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- Applicant's Amendment filed 12/12/2006 is acknowledged.
- Claims 1, 17, and 20 have been amended.
- Claims 1-20 remain pending.

Claim Objections

1. Claim 1 is objected to because of the following informalities:

On line 6, it is believed that "a foreign network" should state
-- to a foreign network--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 17 is directed to "information **packet**," which is not a process, machine, manufacture, or composition of matter. A packet is a mere data structure. Although, claim 17 initially claims a node, it also claims an information packet and the body of the claim describes data fields of the packet. There are no structures of the node recited as would be required if a node is claimed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-8,

Claim 1 recites the limitation "the sub-type data field" in line 13. There is insufficient antecedent basis for this limitation in the claim. It is suggested that the phrase, "the sub-type data field, a sub-type data field designating" be changed to "a sub-type data field, the sub-type data field designating."

In claims 1-8, the use of the term "connectable" in the context of this claim renders the claim indefinite for the following reason:

- In claim 1, the word "connectable" implies that the node may not be connected to anything. However, the claim requires connections between the node and other nodes in a home network and a foreign network. Furthermore, the claim requires the use of an information packet, and a packet exists only in an environment of interconnected nodes with data transmission taking place. To summarize, there is a contradiction between the scope sought by the use of the word "connectable" and the scope defined by the body of the claim which requires an actual connection.

6. Regarding claims 17-20,

In claim 17, it is not clear what is meant by:

- On line 5, "a generalized link-layer address extension." An address extension is a field, which is not a physical element. The claim is directed to a node, thus it must be comprised of physical elements within the node.

Corrections are required.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1-20,

Claims 1, 9, and 17 on lines 9, 8, and 13, respectively, contain new matter which is not described in the specification. More specifically, the statement "information packet that can comprise a plurality of message types," is not described in the specification. The Applicants' specification on pg. 18, lines 20-25, describes three

specific sub-type embodiments for link layer addresses. Are the Applicants referring to the sub-type embodiments as the "plurality of message types"? If so, then the specification describes how the information packet can comprise *just one* of these message types at ***any one time***, not a "plurality of message types" at the ***same time***. Does the Applicant mean to state -- one of a plurality of message types -- ?

Corrections are required.

Response to Arguments

9. Applicants' arguments of pgs.10-14, filed 12/12/2006, with respect to the rejections of claims 1-20 have been fully considered but they are not persuasive.
- Applicant argues that the term "connectable" is proper and it was the Applicant's belief that many of these issues had been resolved.
 - The Examiner respectfully disagrees. During a telephonic interview of May 25, 2006, the Applicant's representatives and the Examiners did not arrive at any agreement with respect to the claims, specifically concerning the meaning of the term "connectable." (See Interview Summary mailed 6/6/2006) The Applicant's representatives argued during the interview that the Office had previously granted numerous patents that used the term "connectable." Therefore, they argued, the instant Application should be afforded the same treatment insofar as permitting the use of the term "connectable." However, it was and is the position of the Examiner that

the issue is not whether the Applicant can use the term “connectable,” but rather whether it is consistent with the scope sought by the use of the word “connectable” and the scope defined by the body of the claim which requires an actual connection. For example, claim 1’s limitation requires that the node be connected, not merely be “connectable,” since “connectable” implies that the node may be unconnected, in which case the “node connectable to a home network” cannot perform the steps recited in the claim, such as “receiving a plurality of link-layer addresses...related to one of plurality of nodes in a home network.”

- The Applicant argues beginning on page 12 of the Remarks, that the Examiner is mistaken that new matter has been interjected in claims 1, 9, and 17 regarding the phrase “plurality of message types.” The Applicant cites examples from the specification regarding various link-layer address extensions (e.g. cdma2000, Ethernet, Global Identifier). Therefore, the Applicant argues there is support in the specification.
- The Examiner respectfully disagrees. The limitation at issue is “information packet that can comprise a plurality of message types.” The preceding limitation requires that a **single packet** comprise a plurality (more than one) message types. However, the specification describes a packet containing no more than one message type at a time. Thus, an information packet, as described in the specification, cannot comprise a

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plurality of message types. The Examiner maintains that the rejection was proper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Sol whose telephone number is (571) 272-5949. The examiner can normally be reached on M-F 7:30am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

AMS
3/12/2007